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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,229	04/20/2000	ROLF BRANDENBERGER	08846-076001	8809

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EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,229

Applicant(s)

BRANDENBERGER ET AL.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 10-17 and 21-25 is/are allowed.
- 6) ☒ Claim(s) 26-28, 30-35 and 37-42 is/are rejected.
- 7) ☒ Claim(s) 29 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 line 1, "the sprayed concrete" lacks clear antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 27, 28, 34, 35, 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Pulkkinen (US 4695188).

Pulkkinen discloses a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means (15); a waterproofing membrane (12) and a layer of reinforcing (fibre) concrete (11). The substrate is given an initial layer of concrete (13). With regards to claim 41, concrete (13) is considered as the fastening means used to secure said waterproofing membrane (12) to said drainage means (15).

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With regards to claims 34, 35, 40, 42, the recited method steps are considered to be inherent to the use of the apparatus disclosed by Pulkkinen.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26,30-33, 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen '188 in view of Wipo document (98/24738).

Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen lacks a waterproofing membrane being a plastics material and a layer of coalesced particles of thermoplastic polymer formed from a sprayed aqueous dispersion. Wipo document '738 teaches a waterproofing membrane being a layer of coalesced particles of thermoplastic polymer and a layer of sprayed concrete containing reinforcing fibers (see abstract and pages 2-5). It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by substituting the waterproofing means as taught by Wipo '738 for the waterproofing means disclosed by Pulkkinen since such a substitution would allow for the layer of concrete (meaning the initial layer of concrete and the outermost layer of concrete) to make a more effective bonding with the waterproofing membrane.

With regards to claim 30, Wipo '738 discloses that the waterproofing membrane is a plastics material with anchoring means for subsequent layers (see page 3).

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With regards to claim 32 and 33, Pulkkinen is silent about the reinforcing concrete being sprayed. Wipo '738 teaches the layer of reinforced fiber concrete is applied by spraying (see pages 4 and 5). It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by spraying on the reinforced fibre concrete (11) as taught by Wipo '738 since creating the cladding would be simpler since the waterproofing member as well as the initial concrete were sprayed on.

With regards to claims 37-39, the recited method steps are considered to be obvious in view of the combination as described above.

Allowable Subject Matter

6. Claims 1-8, 10-17, 21-25 are allowed.
7. Claims 29 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 9/8/03 have been fully considered but they are not persuasive. Applicant argues that Pulkkinen teaches to have a reinforced plastic layer in between the waterproofing membrane and the layer of concrete. The examiner agrees; however, there is nothing in the claim that precludes having such an intermediate layer. The applicant alleges that the structure disclosed by Pulkkinen teaches to keep water in. The examiner fails to see such language in the Pulkkinen reference. Instead, in column 1 of the Pulkkinen reference it is clear that Pulkkinen wants to keep water out (see col. 1 lines 12-18). It should be further noted that substituting the waterproofing

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means as taught by Wipo '738 for the waterproofing means disclosed by Pulkkinen does not destroy Pulkkinen in anyway.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one skilled in the art would modify Pulkkinen by substituting the waterproofing means as taught by Wipo '738 for the waterproofing means disclosed by Pulkkinen since such a substitution would allow for the layer of concrete (meaning the initial layer of concrete and the outermost layer of concrete) to make a more effective bonding with the waterproofing membrane.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.


HEATHER SHACKELFORD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Sunil Singh

Patent Examiner
Art Unit 3673

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GS
12/2/03